

FITZPATRICK, CELLA, HARPER & SCINTO
MEMORANDUM RE COMPLIANCE WITH DUTY OF DISCLOSURE

U.S. patent law imposes a "duty of disclosure" on certain individuals in connection with each patent application, which is filed by such individuals, and which is pending in the U.S. Patent and Trademark Office (the "USPTO").

The following is a brief summary of the duty of disclosure.

1. What is the duty of disclosure?

The duty of disclosure is a duty of candor and good faith in dealing with the USPTO. It includes the duty to disclose to the USPTO all information known to the individual to be material to the patentability of the subject matter claimed in the application.

2. What is the consequence of failure to comply with the duty of disclosure?

Any patent issuing from a patent application for which the duty of disclosure was not satisfied may be held to be unenforceable.

3. Who has the duty of disclosure?

- a) Each inventor contributing to the subject matter of at least one claim in the patent application;
- b) Each attorney or agent who prepares or prosecutes the patent application; and
- c) Every other individual who is substantively involved with the preparation or prosecution of the patent application and who is associated with the inventors or their assignee.

4. What is "material information"?

It is information which, either taken by itself or in combination with other known information, would:

- a) establish the unpatentability of any claim in the patent application as being anticipated or obvious to one of ordinary skill in the art; or

- b) refute, or be inconsistent with a position taken by the applicant in asserting patentability or in opposing an argument of unpatentability of any pending claim; or
- c) otherwise be important to a reasonable Patent Examiner in deciding whether to allow a pending claim.

5. **What does "material information" include?**

It includes:

- a) information indicating that any claim in the patent application may have been in public use or on sale (a mere offer for sale is sufficient) in the United States more than one year before the U.S. patent application filing date;
- b) information indication that any claim in the patent application may have been originally obtained from someone other than the inventor(s) named in the patent application; and
- c) relevant prior art, namely relevant information that was:
 - i) patented or published anywhere before the invention date; or
 - ii) disclosed in a patent granted on or a U.S. patent application publication of a U.S. patent application filed by another, if that U.S. patent application was filed prior to the invention claimed in the patent application under consideration; or
 - iii) disclosed in the publication of an international application filed under the Patent Cooperation Treaty (PCT). Such a publication is treated as prior art as of its international filing date if:
 - aa) the international application was filed on or after November 29, 2000;
 - bb) the international application designated the U.S.; and
 - cc) the international application was published in English.

If the international application was filed prior to November 29, 2000, the publication is prior art only as of its publication date.

PLEASE NOTE: Prior art may be material, and therefore subject to the requirement for disclosure to the USPTO, even though:

- a) it does not disclose the whole invention; or
- b) either the inventor or the attorney (or agent) is convinced that it does not make the invention unpatentable.

Material information also includes any information that is inconsistent with a position taken by the applicant as to, or which could raise a question as to:

- a) whether the patent application names all and only true inventors - a named inventor must have contributed to the conception of at least one claim in the patent application;
- b) whether the patent application discloses the best mode of carrying out the invention known to the inventor(s);
- c) whether a commonly-owned patent application or patent contains a claim defining the same invention; or,
- d) whether a patent of a third party contains a claim defining the same invention.

6. What effort must be made to learn of material information?

Each individual who is under a duty of disclosure has a duty to make a reasonable inquiry into any source which that individual believes is likely to contain material information.

Such sources include, but are not limited to:

- a) the results of any searches of the prior art that were made in regard to the invention;
- b) search results from counterpart patent applications filed in other countries; and

- c) search results from other patent applications which contain closely-related claimed subject matter.

A prior art search is not required to be conducted prior to filing a patent application in the USPTO, but it is generally preferable to have such a search conducted.

7. How should any doubt regarding disclosure of material information be resolved?

Always, in favor of disclosure to the USPTO.

8. When must material information be disclosed in order to have it considered by the USPTO?

It is advisable to disclose material information along with the filing of a patent application or as soon as possible thereafter. The USPTO has adopted specific time limits, as follows:

- a) Information will be considered if disclosed within three (3) months of the filing date of the patent application or prior to a first office action in the patent application issued by the USPTO on the merits;
- b) Information disclosed later, but prior to a final office action, a Quayle office action (closing prosecution except for formal matters), or a Notice of Allowance, must be accompanied by either a late fee (\$180) or a statement that the information was first cited by any foreign patent office in a counterpart application, or first discovered, not more than three (3) months earlier;
- c) Information disclosed after a final office action, a Quayle office action, or a Notice of Allowance has issued (but before the issue fee is paid) must be accompanied by the statement in b) and a fee of \$180. If the statement cannot be made, consideration by the Patent Examiner can be ensured only by refiling the application or filing a Request for Continued Examination (RCE); or
- d) If the issue fee has been paid, consideration by the Patent Examiner can be ensured only by refiling the application or filing an RCE.

9. **What types of non-English documents may be considered by the Patent Examiner?**

The Patent Examiner may consider a non-English document for which a concise explanation of relevance is provided. This requirement may be satisfied by providing:

- a) an English translation;
- b) a copy of an English version of a foreign search report or communication from a foreign patent office in a counterpart foreign application, indicating the degree of relevance of the document; or
- c) a copy of an English-language counterpart patent or patent application.

10. **Is a partial English translation of a non-English document acceptable?**

Although it is permitted to provide the Patent Examiner with a translation of just the relevant portions of a non-English document, in a recent case the Federal Circuit found that a patent owner committed inequitable conduct by submitting to the USPTO a partial English translation of a reference, in which relevant portions of the reference were omitted.

Therefore, to avoid any risk, we recommend that you to provide us with a complete English translation of any non-English document so that we can submit the complete text to the USPTO.

Some of the other alternatives for satisfying the concise explanation of relevance requirement may also be problematic. For example, an English counterpart document may be submitted in place of an English translation of the non-English document, as long as it is in fact a translation of the entire non-English document. But any differences between the non-English document and its English counterpart may later form the basis of a charge of failure to submit relevant information.

Also, an English translation of a foreign search report or communication from a foreign patent office indicating the degree of relevance of the non-English document may be submitted. But before using this alternative, you should confirm that there is no other portion of the non-English document that the person most knowledgeable about its content considers to be more

relevant than the portion identified in the foreign search report or communication. This alternative has the risk that other portions of the non-English document may later be relied upon to charge that there was a failure to submit relevant information.

In summary, because of the risks involved in other alternatives, we recommend that whenever possible you provide us with a complete English translation of each non-English document to be cited.

11. How is material information disclosed?

By disclosing it to Fitzpatrick, Cella, Harper & Scinto, which will then disclose it to the USPTO in accordance with the requirements of U.S. practice.

12. Additional Recommendations:

We also recommend that you:

- a) inform us of possibly material information as soon as possible;
- b) inform us of any information that leads to the necessity of adding a claim limitation during prosecution of the patent application;
- c) provide us with all search reports in any foreign counterpart patent applications and related U.S. patent applications and, if submitted more than three (3) months after filing or receipt of the first office action or search report in any of those counterpart patent applications and related U.S. patent applications, advise us whether the statement set forth in paragraphs 8(b) and (c), above, can be made;
- d) inform us of anything that may have affected the patentability of a claim canceled during prosecution of the patent application;
- e) provide us with any information that another person cites to you as being relevant to patentability of a claim (e.g., in an opposition or licensing discussion); and
- f) inform us, while the patent application is pending in the USPTO, whenever it is discovered that any incorrect or incomplete statement was made during prosecution of the patent application.

Finally, we remind you that the duty to disclose material information continues for the entire pendency of a patent application.

Please do not hesitate to contact us with any questions that you may have regarding the foregoing recommendations and the duty of disclosure.

(Revised February 2003)

© Fitzpatrick, Cella, Harper & Scinto 1999, 2000, 2003

Form #146